REMARKS

Claims 1-20 remain in the application. No amendment to the claims has been made in the present Response.

Claim Rejections - 35 USC §103

Claims 1–6 and 9–20 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application No. 5,945,471 to Morita et al. (the '471 patent) in view of U.S. Patent Application No. 5,472,493 to Regan (the '493 patent), with claim 13 further rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent Application No. 5,387,624 to Morita et al. (the '624 patent). Further, claims 7 and 8 stand rejected under 35 U.S.C. §103(a) as being obvious over the '471 patent in view of the '493 patent. The Applicants respectfully traverse these rejections. The Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness with regard to independent claims 1 and 7.

To summarize, claim 1 encompasses a composite cured silicone powder. The composite cured silicone powder comprises cured silicone powder (A) that has an average particle size of 0.1 to 500 micrometers. An inorganic fine powder (B) is coated on a surface of the cured silicone powder (A). A surface-active agent (C) is coated on a surface of the inorganic fine powder (B). Claim 7 encompasses a method for producing the composite cured silicone powder of claim 1. The method comprises mixing components (A), (B), and (C) under conditions of mechanical shearing.

In the instant Office Action, it is clear that the Examiner has chosen to utilize the teaching-suggestion-motivation (TSM) test in an attempt to establish a *prima facie* case of obviousness. The Supreme Court in ***KSR International Co. v. Teleflex Inc.***, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. See MPEP §2143. The TSM test remains as one of the rationales that may be used to support a *prima facie* case of obviousness. See MPEP §2143 (G). Under the TSM test, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143 (G). In addition, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See MPEP §2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

Existing precedent provides guidance for establishing a motivation to modify a reference or references. In particular, "[t]he motivation to modify the prior art **must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention**." (Emphasis added). See *Alza Corp. v. Mylan Laboratories Inc.,* 391 F.3d 1365 (Fed. Cir. 2004). The mere fact that references can be combined or modified **does not** render the resultant combination obvious

unless the prior art also suggests the **desirability** of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Applicants respectfully assert that the Examiner has failed to establish a motivation to combine the teachings of '471 and '493 patents to arrive at the instant invention as is claimed in the present application. In the instant Office Action, the Examiner appropriately recognizes that the '471 patent **does not** explicitly teach a surface-active agent (C) which is coated on the inorganic fine powder (B), and as is taught and claimed in the present application. The Examiner then suggests that the '471 and '493 patents are "combinable because they are concerned with a similar technical difficultly, namely, silicas". The Applicants note that the ability to combine two references is not the standard for satisfying the requirement that there be a **motivation** to combine. In fact, the Applicants assert that the disparate objectives of the '471 and '493 patents prove that there is no motivation to make the asserted combination. To illustrate, the object of the '471 patent is "to provide a very flowable and **highly water repellent composite cured silicone powder** and a method for the preparation of this **composite cured silicone powder**." (See column 1, lines 46-50, emphasis added). The Examiner asserts that the '471 patent is concerned with silicas, however, micropowders, e.g. amorphous silica, is **merely one component** of the composite cured silicone powder of the '471 patent, and is in no way a focus of the '471 patent. *Conversely*, the object of the '493 patent does focus on silica, specifically "a **novel silica** that is a versatile and efficient **rheological additive** for aqueous coatings and other industrial applications. A further objective is to provide **an agent** that fosters stability in

aqueous compositions. A still further objective is to provide **a novel silica** which is an effective **anti-settling agent**." (See column 1, lines 58-64, emphasis added). *Notably*, the '493 patent **never** discloses, teaches, or even suggests silicone powders (composite or not), and more importantly, **never uses the word "silicone" period**. In sum, the Applicants assert that the objectives of the '471 and '493 patents are in no way related, and therefore, those skilled in the art would not be motivated to supplement the deficiencies of the '471 patent with the teachings of the '493 patent or vice versa.

Unlike the prior art, the object of the present invention is "to provide a **composite cured silicone powder** of excellent flowability, **hydrophilicy**, and **dispersibility**. It is another object to provide a method of manufacturing the aforementioned powder." (See paragraph [0007], emphasis added). As noted in the Background Art section of the present application, the Applicants are aware of previous composite cured silicone powders, such as the silicone powder of the '471 patent. *However*, as described in the instant specification, "[c]omposite cured silicone powders with adherence of the inorganic fine powder to the surfaces of the composite powders and with improved flowability have been proposed... **[t]hese composite cured silicone powders, however, exhibit poor hydrophilicity**..." (See paragraph [0004], emphasis added). As described above, the surface-active agent (C) is coated on the surface of the inorganic fine powder (B), as taught and claimed in the present application. "The surface-active agent (C), which in the composite cured silicone powder is present on the surfaces of the inorganic fine powder particles, is a component that **improves hydrophilic properties of the composite cured silicone powder**." (See paragraph [0047],

emphasis added). As described above, the composite cured silicone powder of the '471 patent is **highly water repellent**, i.e., is **highly hydro*phobic*. The '471 patent makes it clear that the hydrophobic nature of the composite cured silicone powder is an advantage of that invention.** (See for example column 6, lines 1-6). *Conversely*, as also described above, the composite cured silicone powder of the present invention has excellent **hydro*philic*** properties, i.e., the composite cured silicone powder of the present invention is completely opposite the composite cured silicone powder of the '471 patent with regard to water repellency. Further, if anything, '471 patent teaches and focuses on the use of non-crosslinking oils to achieve excellent hydrophobicity, and therefore, one skilled in the art would have no reason or motivation to modify the '471 patent to use other components that would hamper the hydrophobicity of the composite cured silicone powder. (See column 4, lines 37-41). "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See MPEP §2143.01 V. citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Further, as reinforced in the examples of the '471 patent, the "Present Invention" examples are water repellent/**hydrophobic**, which are designated by "O", whereas the "Reference Examples" and "Comparison Examples" are **hydrophilic**, and are designated by "x". (See column 10, lines 24-34 and column 6, lines 60-64.) One skilled in the art, when looking at the '471 patent, will readily appreciate that achieving excellent hydrophobicity with regard to the composite cured silicone powders is a primary goal of the '471 patent, and

therefore, would **not be motivated** to look for ways to directly contravene this goal, i.e., to look for a way to make the composite cured silicone powders more hydrophilic *rather than* more hydrophobic.

As described above, the '493 patent focuses on a novel silica that used, in and of itself, primarily for rheology control, i.e., to increase viscosity of aqueous compositions, and for prevention of settling in such compositions. In other words, the novel silica of the '493 patent is merely an additive/agent for use in aqueous compositions. Unlike the present invention, the '493 patent is **not directed at all to the coating of silicone powder with inorganic powder**. Further, **all** of the examples of the '493 patent focus on increasing viscosity of an aqueous composition through use of the novel silica relative to when a silica and a surfactant are used separately. The Applicants assert that the reasons why silicone powder is coated with inorganic powder are **not at all related** to the use of silicas as rheological control agents. (See paragraph [0042] of the present application).

In view of the foregoing, the Applicants respectfully submit that claims 1 and 7 are both novel and non-obvious, in view of the disclosure, teachings, and suggestions of the prior art such that claims 1 and 7, as well as the claims that depend therefrom, are in condition for allowance.

If any additional fees are necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

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